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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO.
09/018,664	02/04/98	ESHEL	U 526/20

QM31/1028

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EXAMINER	
GRING, N	
ART UNIT	PAPER NUMBER
3734	4
DATE MAILED:	10/28/98

Please find below a communication from the EXAMINER in charge of this application.

Commissioner of Patents

Office Action Summary

Application No.	09/010,664	Applicant(s)	Eschel et al.
Examiner	Gring	Group Art Unit	3734

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

Responsive to communication(s) filed on 8-13-98

This action is **FINAL**.

Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

Claim(s) 1 - 11 is/are pending in the application.

Of the above claim(s) 9 - 11 is/are withdrawn from consideration.

Claim(s) 1 - 8 is/are allowed.

Claim(s) is/are rejected.

Claim(s) is/are objected to.

Claim(s) are subject to restriction or election requirement.

Application Papers

See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

The proposed drawing correction, filed on _____ is approved disapproved.

The drawing(s) filed on _____ is/are objected to by the Examiner.

The specification is objected to by the Examiner.

The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

All Some* None of the CERTIFIED copies of the priority documents have been received.

received in Application No. (Series Code/Serial Number) _____.

received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

Attachment(s)

Information Disclosure Statement(s), PTO-1449, Paper No(s). _____ Interview Summary, PTO-413

Notice of Reference(s) Cited, PTO-892 Notice of Informal Patent Application, PTO-152

Notice of Draftsperson's Patent Drawing Review, PTO-948 Other _____

Office Action Summary

Art Unit: 3734

DETAILED ACTION

Election/Restriction

1. Applicant's election without traverse of claims 1-8 in Paper No. 4 is acknowledged.
2. Claims 9-11 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b) as being drawn to a non-elected species. Election was made **without** traverse in Paper No. 4.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- In claim 1, no means is provided for inflation of the balloon.
- In claim 5, line 3, it is unclear what portion of the device is "hollow".
- In claim 5, no means is provided for the inflation of the balloon.
- Claim 6 is either missing or misnumbered.

Art Unit: 3734

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

6. Claims 1-4, 7 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by Kraus et al.

Kraus et al discloses a first tubular member (71), a second tubular member (76) with a balloon thereon and a connecting tube (52) of substantially smaller diameter.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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8. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kraus et al in view of Lord.

Kraus et al discloses the invention substantially as claimed except for guiding element in use with the catheter. Lord discloses a catheter or guiding element with a closed end and balloon attached thereto for insertion into the urethra. It would have been obvious to one of ordinary skill in the art to modify the device of Kraus et al by replacing the guidewire with the device of Lord in order to facilitate the placement of the catheter in the patient.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to N. Kent Gring whose telephone number is (703) 308-2214. The examiner can normally be reached on Monday - Friday from 9:00 a.m. to 5:00 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins, can be reached on (703) 308-1344. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3590.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

N. Kent Gring
n/s

22 October 1998

C. M. McD
CORRINE M. McDERMOTT
PRIMARY EXAMINER
GROUP 3300

The drawings submitted with this application were declared informal by the applicant. Accordingly, they have not been reviewed by a draftsperson at this time. When formal drawings are submitted, the draftsperson will perform a review.

Direct any inquiries concerning drawing review to the Drawing Review Branch (703) 305-8404.